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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,786	02/13/2002	John E. Holland	3781-002 (03781.0024.1)	9809
26158	7590	11/30/2005	EXAMINER	
WOMBLE CARLYLE SANDRIDGE & RICE, PLLC			MAYO III, WILLIAM H	
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ATLANTA, GA 30357-0037			PAPER NUMBER	
			2831	

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/075,786

Applicant(s)

HOLLAND ET AL.

Examiner

William H. Mayo III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 27-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 27-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>August 4, 2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The declaration under 37 CFR 1.132 filed May 27, 2005 is insufficient to overcome the rejection of claims 1-13 and 27-40 based upon 35 USC 103(a), as set forth in the last Office action because: While the applicant has stated that there was a long felt need for an anti-chafe cover, commercial success of the anti-chafe cover and that the differences in the price of Spectra® and Cordura® would not have made utilizing Spectra® as an anti-chafe cover would not have been obvious because no one has ever done so, the examiner finds the statement unpersuasive. It is the examiner's position and the Board of Appeals position, that there exist a bona-fide prima facie case of obviousness, and that based on the teachings of the references (Andrieu and Holland), it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the protective cover, which is made of polyester fibers, of Andrieu to comprise the Spectra® fibers and the fabric parameters of the protective fabric as taught by Holland because Holland teaches that such a fabric by made of commercially available Spectra® fibers and having the specified parameters, overcomes the disadvantages of polyester fabric covers (Col 2, lines 16-23), has minimal weight, increased abrasion resistance, tear strength, cut and stab resistance, and is compatible with the environment in which the cover is used (Col 1, lines 5-10) and since it has been held to be within general skill of a worker in the art to select a commercially available or known material on the basis of its suitability for the

intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

However, a more detailed rebuttal is provided at the request of the applicant under the Response to Arguments heading. Based on the above and rebuttal arguments, a maintained rejection follows below.

Information Disclosure Statement

2. The information disclosure statement filed August 4, 2005 has been submitted for consideration by the Office. It has been placed in the application file and the information referred to therein has been considered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-9 and 27-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andrieu (Pat Num 5,300,337) in view of Holland et al (Pat Num 5,395,682, herein referred to as Holland). Andrieu discloses a protective cover (Figs 1-4) for cables or hoses (abstract), which are capable of being used in environments wherein the cover (Figs 1-4) may be subject to abrasion and weather extremes (i.e. heat, Col 1, lines 12-20). Specifically, with respect to claim 1, Andrieu discloses a protective cover (10) comprising a sleeve (Figs 1-2, Col 3, lines 55-59) capable of surrounding a cable or hose (abstract, Fig 4), wherein the sleeve has open ends (left and right ends) and is formed of a fabric (10) made of substantially high strength yarn (11, i.e. polyester, Col 3, lines 8-12). With respect to claim 2, Andrieu discloses that the fabric (11) is formed from at least 70 percent high strength yarns (i.e. 100 % polyester). With respect to claim 6, Andrieu discloses that the high strength yarn (11, i.e. polyester) is about 400 to 1000 denier (i.e. 600-2500, Col 3, lines 60-67). With respect to claim 7, Andrieu discloses that the fabric covering (10) has a warp and fill density of about 40 ends per inch (Col 4, lines 1-10). With respect to claim 8, Andrieu discloses that the sleeve (Fig 1) is formed as an elongated sheet having opposing longitudinal edges (top and bottom edges), wherein the opposed longitudinal edges (top and bottom edges) includes means (15) for releasably attaching the opposed longitudinally edges together (Col 4, lines 24-31) around the length of a cable or hose (abstract, Fig 4). With respect to claim 9, Andrieu discloses that the means (15) for fastening the longitudinal edges comprises

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hook and loop material (see 15, Col 4, lines 35-47). With respect to claim 27, Andrieu discloses an abrasion resistant cable system (Fig 4) comprising a cable (not numbered) that is subject to being periodically moved across abrasion surfaces (Col 1, lines 12-20) and a protective sleeve (10) surrounding the cable, which is formed from a fabric made of substantially high performance yarn (i.e. polyester), has open ends (left and right ends), and protects the cable (Fig 4) from abrasion and wear thereof (Col 1, lines 12-20). With respect to claim 28, Andrieu discloses that the fabric (11) is formed from at least 70 percent high strength yarns (i.e. 100 % polyester). With respect to claim 32, Andrieu discloses that the high strength yarn (11, i.e. polyester) is about 400 to 1000 denier (i.e. 600-2500, Col 3, lines 60-67). With respect to claim 33, Andrieu discloses that the fabric covering (10) has a warp and fill density of about 40 ends per inch (Col 4, lines 1-10). With respect to claim 34, Andrieu discloses that the sleeve (Fig 1) is formed as an elongated sheet having opposing longitudinal edges (top and bottom edges), wherein the opposed longitudinal edges (top and bottom edges) includes means (15) for releasably attaching the opposed longitudinally edges together (Col 4, lines 24-31) around the length of a cable or hose (abstract, Fig 4). With respect to claim 35, Andrieu discloses that the means (15) for fastening the longitudinal edges comprises hook and loop material (see 15, Col 4, lines 35-47).

However, Andrieu doesn't necessarily disclose the protective cover being made of a high performance yarns having a tensile modulus equal to or greater than 150g/denier and a tenacity equal to or greater than 7 grams/denier, wherein the yarns are cut and tear resistant (claims 1 & 27), nor the protective cover being made of a

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material fabric having a weight of between about 5 & 8 ounces per square yard (claims 3 & 29), nor the fabric being resistant to petroleum based products (claims 4 & 30), nor the high strength yarn being selected from the group consisting of long chain polyethylenes, high strength aramids, liquid crystal polymers, and combinations thereof (claims 5 & 31), nor the fabric density of between about 30 and 36 inches per inch (claims 7 & 33).

Holland teaches a protective cover, that is made of Spectra® fibers (Col 2, lines 28-37), that overcomes the disadvantages of polyester fabric covers (Col 2, lines 16-23), has minimal weight, increased abrasion resistance, tear strength, cut and stab resistance, and is compatible with the environment (Col 1, lines 5-10). Specifically, with respect to claim 1, Holland teaches that the protective cover is made of high performance yarns, such as Spectra® fibers that inherently has a tensile modulus equal to or greater than 150g/denier and a tenacity equal to or greater than 7 grams/denier. With respect to claim 3, Holland teaches that the fibers may be used to form a fabric having a weight of between about 5 & 8 ounces per square yard (Col 2, lines 49-51) for the purpose of providing a fabric that is lightweight while also providing a sufficient strength and durability to withstand the use and environment to the fabric is exposed (Col 2, lines 51-56). With respect to claim 4, Holland teaches that the fabric formed of Spectra® fibers are chemical resistance to petroleum-based products (Col 4, lines 45-51). With respect to claim 5, Holland teaches that the fabric containing Spectra® fibers, which are long chain extended polyethylene (Col 2, lines 25-30). With respect to claims 7, Holland teaches that the fabric may be constructed to have a warp and fill density of

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between 30 and 36 ends per inch (Col 2, lines 49-51). With respect to claim 27, Holland teaches that the protective cover is made of high performance yarns, such as Spectra® fibers that inherently has a tensile modulus equal to or greater than 150g/denier and a tenacity equal to or greater than 7 grams/denier. With respect to claim 29, Holland teaches that the fibers may be used to form a fabric having a weight of between about 5 & 8 ounces per square yard (Col 2, lines 49-51) for the purpose of providing a fabric that is lightweight while also providing a sufficient strength and durability to withstand the use and environment to the fabric is exposed (Col 2, lines 51-56). With respect to claim 30, Holland teaches that the fabric formed of Spectra® fibers are chemical resistance to petroleum-based products (Col 4, lines 45-51). With respect to claim 31, Holland teaches that the fabric containing Spectra® fibers, which are long chain extended polyethylene (Col 2, lines 25-30). With respect to claim 33, Holland teaches that the fabric may be constructed to have a warp and fill density of between 30 and 36 ends per inch (Col 2, lines 49-51).

With respect to claims 1-9 and 27-35, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the protective cover, which is made of polyester fibers, of Andrieu to comprise the Spectra® fibers and the fabric parameters of the protective fabric as taught by Holland because Holland teaches that such a fabric by made of commercially available Spectra® fibers and having the specified parameters, overcomes the disadvantages of polyester fabric covers (Col 2, lines 16-23), has minimal weight, increased abrasion resistance, tear strength, cut and stab resistance, and is compatible with the environment in which the

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cover is used (Col 1, lines 5-10) and since it has been held to be within general skill of a worker in the art to select a commercially available or known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

6. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ratigan (Pat Num 5,441,790) in view of Holland et al (Pat Num 5,395,682). Ratigan discloses a protective cover (1) for use with a rope (Figs 1-4), and which is used in environments in which lengths of the rope are subject to abrasion (Col 1, lines 5-10). Specifically, with respect to claim 40, Ratigan discloses an abrasion resistant rope (5) of the type that is capable of periodically moved across abrasive surfaces (Col 1, lines 62-68) comprising a sleeve (Fig 1) surrounding a length of a rope (5), wherein the sleeve (Fig 1) is formed of a fabric (i.e. textile material) made of substantially high strength yarn (i.e. polyester fibers, Col 2, lines 1-3).

However, Ratigan doesn't necessarily disclose the protective cover being made of a high performance yarns having a tensile modulus equal to or greater than 150g/denier and a tenacity equal to or greater than 7 grams/denier, wherein the sleeve is cut resistant or cut resistant (claim 40).

Holland teaches a protective cover, that is made of Spectra® fibers (Col 2, lines 28-37), that overcomes the disadvantages of polyester fabric covers (Col 2, lines 16-23), has minimal weight, increased abrasion resistance, tear strength, cut and stab resistance, and is compatible with the environment (Col 1, lines 5-10). Specifically, with respect to claim 40, Holland teaches that the protective cover is made of high

performance yarns, such as Spectra® fibers that inherently has a tensile modulus equal to or greater than 150g/denier and a tenacity equal to or greater than 7 grams/denier.

With respect to claim 40, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the protective cover, which is made of polyester fibers, of Andrieu to comprise the Spectra® fibers and the fabric parameters of the protective fabric as taught by Holland because Holland teaches that such a fabric by made of commercially available Spectra® fibers and having the specified parameters, overcomes the disadvantages of polyester fabric covers (Col 2, lines 16-23), has minimal weight, increased abrasion resistance, tear strength, cut and stab resistance, and is compatible with the environment in which the cover is used (Col 1, lines 5-10) and since it has been held to be within general skill of a worker in the art to select a commercially available or known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

7. Claims 10-12 and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andrieu (Pat Num 5,300,337) in view of Holland et al (Pat Num 5,395,682, herein referred to as modified Andrieu), as applied to claims 1 and 27 above, further in view of Kite, III et al (Pat Num 4,891,256, herein referred to as Kite).

Modified Andrieu discloses a protective cover (Figs 1-4) for cables or hoses (abstract), which are capable of being used in environments wherein the cover (Figs 1-4) may be subject to abrasion and weather extremes (i.e. heat, Col 1, lines 12-20) as described above. Specifically, with respect to claim 10, modified Andrieu discloses a protective cover (10) comprising a sleeve (Figs 1-2, Col 3, lines 55-59) capable of surrounding a

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cable or hose (abstract, Fig 4). With respect to claim 11, modified Andrieu discloses that the sleeve (Fig 1) is formed having opposing longitudinal edges (top and bottom edges), wherein the opposed longitudinal edges (top and bottom edges) includes means (15) for releasably attaching the opposed longitudinally edges together (Col 4, lines 24-31) around the length of a cable or hose (abstract, Fig 4). With respect to claim 12, modified Andrieu discloses that the means (15) for fastening the longitudinal edges comprises hook and loop material (see 15, Col 4, lines 35-47). With respect to claim 36, modified Andrieu discloses a protective cover (10) comprising a sleeve (Figs 1-2, Col 3, lines 55-59) capable of surrounding a cable or hose (abstract, Fig 4). With respect to claim 37, modified Andrieu discloses that the sleeve (Fig 1) is formed having opposing longitudinal edges (top and bottom edges), wherein the opposed longitudinal edges (top and bottom edges) includes means (15) for releasably attaching the opposed longitudinally edges together (Col 4, lines 24-31) around the length of a cable or hose (abstract, Fig 4). With respect to claim 38, modified Andrieu discloses that the means (15) for fastening the longitudinal edges comprises hook and loop material (see 15, Col 4, lines 35-47).

However, modified Andrieu doesn't necessarily disclose the sleeve being a plurality of bands comprising a short length of the fabric and being spaced apart along the length of the cable or hose (claims 10 & 36), nor each band having opposed longitudinally edges including means for fastening the opposed longitudinally edges together around the length of the cable (claims 11 & 37).

Kite teaches a wraparound closure device (Figs 1-4) made of a fabric that protects elongated substrates, such as cables, from abrasion (Col 1, lines 5-10). Specifically, with respect to claims 10 & 36, Kite teaches a wraparound sleeve (10-Fig 3) that may be made of polyester (Col 4, line 49-50) and is formed as a plurality of bands (see three fabric sleeves not numbered) wherein each band comprises a short length of the fabric which are spaced apart along the length of the cable (Fig 3) for the purpose of providing effective bundling device that accommodates multiple cable break-outs (Col 1, lines 38-45). With respect to claims 11 & 37, Kite teaches that each short length of fabric (see 3 section of fabric, Fig 3) having opposed longitudinally edges (left and right sides of all three fabrics) wherein the opposed longitudinally edges has means (24, 30, & 32) for fastening the opposed longitudinally edges together around a length of the cable (Fig 3).

With respect to claims 10-11 & 36-37, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the polyester protective cover of modified Andrieu to comprise a multiple protective covers as taught by the Kite because Kite teaches that such a fabric configuration protects elongated articles from abrasion (Col 4, lines 5-8) and provides effective bundling device that accommodates multiple cable break-outs (Col 1, lines 38-45) and since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. (*St. Regis Paper Co v. Bemis Co.*, 193 USPQ 8).

8. Claims 13 & 39 rejected under 35 U.S.C. 103(a) as being unpatentable over Andrieu (Pat Num 5,300,337) in view of Holland et al (Pat Num 5,395,682, herein

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referred to as modified Andrieu), as applied to claims 1 and 27 above, further in view of Holt et al (Pat Num 5,070,597, herein referred to as Holt). Modified Andrieu discloses a protective cover (Figs 1-4) for cables or hoses (abstract), which are capable of being used in environments wherein the cover (Figs 1-4) may be subject to abrasion and weather extremes (i.e. heat, Col 1, lines 12-20) as detailed above with reference to claims 1 & 27.

However, modified Andrieu doesn't necessarily disclose the protective cover further comprising a hood made of the same fabric and fastened to at least one end of the sleeve for protecting the exposed end of the cable or hose (claims 13 & 39).

Holt teaches a double wall protective cover (Figs 1-19b) comprising flame retardant, abrasion resistance, and split or tear resistance (Col 18, lines 21-26), for the purpose of providing environmental protection, including electrical protection, and joining or mechanical holding of substrates such as cables or pipes (Col 1, lines 17-21). Specifically, with respect to claims 13 & 39, Holt discloses that the protective cover (Figs 1-19b) may be formed of polyester (Col 7, line 36) and as a hood (i.e. end cap, 19, Figs 6a-d), wherein the hood (19) may be fastened to at least one end of the cable or pipe (22) for protecting the exposed end of the cable or pipe (22, Col 29, lines 23-24).

With respect to claims 13 & 39, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the cable or pipe assembly of modified Andrieu to comprise a end cap protective cover formed of fabric as taught by the Holt because Holt teaches that fabrics, having excellent flame retardant, abrasion resistance, and split or tear resistance (Col 18, lines 21-26), are

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commonly used to protect cables and pipes are sometimes formed as end cap cover configuration that provides environmental protection, including electrical protection for the joining or mechanical holding of substrates such as cables or pipes (Col 1, lines 17-21) and also provides protection for the exposed ends of cables or pipes (Col 29, lines 23-24).

Response to Arguments

9. Specifically, the Applicant's arguments filed May 27, 2005 have been fully considered but they are not persuasive. The applicant argues:

- A) The declaration states that the claimed invention cannot be obvious because there exist a (1) long felt but unsolved need, (2) failure of others to invent the claimed invention, (3) unexpected results and (4) commercial success
- B) The Board states that "Andrieu cover is not formed from high performance yarns and therefore the examiner cannot continue to assert that Andrieu discloses a high strength yarn.

With respect to argument A, the examiner respectfully traverses. Firstly, it must be stated that the examiner is given strict guidelines for determining whether an declaration. Firstly, the examiner recognizes that the record has to be considered as a whole with respect to the declaration submitted. Specifically, Section 716.01(d) specifically cites

716.01(d) [R-2] Weighing Objective Evidence

IN MAKING A FINAL DETERMINATION OF PATENTABILITY,

EVIDENCE SUPPORTING PATENTABILITY MUST BE WEIGHED
AGAINST EVIDENCE SUPPORTING PRIMA FACIE CASE

When an applicant >timely< submits evidence traversing a rejection, the examiner must reconsider the patentability of the claimed invention. The ultimate determination of patentability must be based on consideration of the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. In *re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The submission of objective evidence of patentability does not mandate a conclusion of patentability in and of itself. In *re Chupp*, 816 F.2d 643, 2 USPQ2d 1437 (Fed. Cir. 1987). Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of a prima facie case was reached, not against the conclusion itself. In *re Eli Lilly*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990). In other words, each piece of rebuttal evidence should not be evaluated for its ability to knockdown the prima facie case. All of the competent rebuttal evidence taken as a whole should be weighed against the evidence supporting the prima facie case. In *re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Although the record may establish evidence of secondary considerations which are indicia of nonobviousness, the record may also establish such a strong case of obviousness that the objective evidence of nonobviousness is not sufficient to outweigh the evidence of obviousness. *Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 769, 9 USPQ2d 1417, 1427 (Fed. Cir. 1988), cert. denied, 493 U.S. 814 (1989); *Richardson-Vicks, Inc., v. The Upjohn Co.*, 122 F.3d 1476, 1484, 44 USPQ2d 1181, 1187 (Fed. Cir. 1997) (showing of unexpected results and commercial success of claimed ibuprofen and psuedoephedrine combination in single tablet form, while supported by substantial evidence, held not to overcome strong prima facie case of obviousness). See In *re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984) for a detailed discussion of the proper roles of the examiner's prima facie case and applicant's rebuttal evidence in

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the final determination of obviousness.

If, after evaluating the evidence, the examiner is still not convinced that the claimed invention is patentable, the next Office action should include a statement to that effect and identify the reason(s) (e.g., evidence of commercial success not convincing, the commercial success not related to the technology, etc.). See *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir.), cert. denied, 488 U.S. 956 (1988). See also MPEP § 716.01. See MPEP § 2144.08, paragraph II.B., for guidance in determining whether rebuttal evidence is sufficient to overcome a prima facie case of obviousness.

Given the above statement, the examiner respectfully submits the following: In order to establish long felt but unsolved need, the applicant is required to submit objective evidence that an art recognized problem exist in the art for a long period of time without solution. While the applicant has submitted exhibits to establish long felt need, the exhibits are found not to be persuasive. As stated above, in the MPEP, facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of a prima facie case was reached, not against the conclusion itself. In *re Eli Lilly*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990). In other words, each piece of rebuttal evidence should not be evaluated for its ability to knockdown the prima facie case. All of the competent rebuttal evidence taken as a whole should be weighed against the evidence supporting the prima facie case. In *re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). When evaluating the objective evidence and the prima facie case of obviousness, the examiner states the following. (1) The teaching of Holland clearly teaches a protective cover that is that is made of Spectra® fibers (Col 2, lines 28-37), that overcomes the disadvantages of prior art polyester fabric

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covers (Col 2, lines 16-23), has minimal weight, increased abrasion resistance, tear strength, cut and stab resistance, and is compatible with the environment (Col 1, lines 5-10). (2) The Holland reference was clearly patented more than 1 year prior to the applicant's filing of the above stated application. Based on the above statements, there isn't any factual evidence the claimed invention satisfies a long felt need, because in order to satisfy a long felt need, the long felt need must not have been satisfied by another before the invention by the applicant. *Newell Companies V. Kenney Mfg. Co.*, 864 F 2d 757, 768, 9 USPQ2d 1417, 1426 (Fed Cir. 1988) (Although at one time there was a long felt need for a do it yourself window shade material which was adjustable without the use of tools, a prior art product fulfilled the need by using a scored plastic material which could be torn. "[O]nce another supplied the key element, there was no long felt need or, indeed, a problem to be solved. The Holland reference clearly teaches utilizing the known material Spectra as a protective cover for the exact purpose (i.e. superior abrasion resistant, cut resistant, etc) as the applicant states in the specification (see Page 2 of applicant's specification), prior to the filing of applicant's application. In view of the above statements, it is submitted that the declaration is insufficient to establish a long felt but unsolved need.

With respect to failure of others to invent the claimed invention, clearly as disclosed above, Holland clearly teaches utilizing a protective cover that is that is made of Spectra® fibers (Col 2, lines 28-37), that overcomes the disadvantages of prior art polyester fabric covers (Col 2, lines 16-23), has minimal weight, increased abrasion resistance, tear strength, cut and stab resistance, and is compatible with the

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environment (Col 1, lines 5-10), therefore the declaration is insufficient to establish failure of others to invent the claimed invention.

With respect to unexpected results, it is the opinion of the examiner that such unexpected results was established by Holland, and that such claims by the applicant are unsupported as Holland, in a public document, has stated the properties that the protective cover exhibits. Therefore, the declaration is insufficient to establish unexpected results.

With respect to argument B, the examiner respectfully traverses. The examiner has continually stated that polyester is a high strength material, not high performance material as stated by the applicant. Clearly polyester certainly is a high strength material as it is commonly employed as an abrasion resistant material, as disclosed by the applicant and several prior art reference cited on the record.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Communication

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Mayo III whose telephone number is (571)-272-1978. The examiner can normally be reached on M-F 8:30am-6:00 pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (571) 272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


William H. Mayo III
Primary Examiner
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